

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Martin J. GOLDBERG *et al.*

Application No.: 09/776,770

Filed: February 6, 2001

For: METHODS AND COMPOSITIONS FOR
AMPLIFYING DETECTABLE SIGNALS
IN SPECIFIC BINDING ASSAYS

Group Art Unit: 1634

Examiner: A. Chakrabarti

MAIL STOP ISSUE FEE
Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

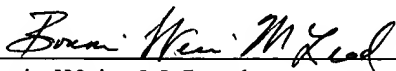
Sir:

LETTER REGARDING INFORMATION DISCLOSURE STATEMENT

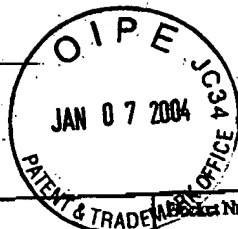
This letter is submitted pursuant to a telephone conference with the Examiner on January 7, 2004, in which the Examiner confirmed that references cited in the Information Disclosure Statement filed February 6, 2001, were considered during prosecution. Consideration of these references is confirmed by the attached copies of the PTO-1449 forms initialed by the Examiner, which Applicants respectfully request be placed in the file to ensure appropriate notation on the issued patent.

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

Dated: January 7, 2004


Bonnie Weiss McLeod
Reg. No. 43,255

CUSTOMER NO. 000033522
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Ave., N.W.
Washington, DC 20004
202.739.3000 (voice)
202.739.3001 (fax)



PTO/SB/08 (2-92)

Sheet 1 of 4

Form PTO-1449

INFORMATION DISCLOSURE CITATION IN AN APPLICATION

(Use several sheets if necessary)

Abstract Number

Application Number

Applicant

Martin J. GOLDBERG et al.

Filing Date

Group Art Unit

U.S. PATENT DOCUMENTS

Examiner Initials	Ref. No.	Date	Document No.	Name	Class	Subclass	Filing Date If Appropriate
AC	1.	12/08/87	4,711,955	Ward et al.			
	2.	11/21/89	4,882,269	Schneider et al.			
	3.	03/20/90	4,910,300	Urdea et al.			
	4.	06/23/92	5,124,246	Urdea et al.			
	5.	09/01/92	5,143,854	Pirung et al.			
	6.	12/29/92	5,175,270	Nilsen et al.			
	7.	10/12/93	5,252,743	Barrett et al.			
	8.	05/10/94	5,310,523	Smethers et al.			
	9.	10/25/94	5,359,100	Urdea et al.			
	10.	01/24/95	5,384,261	Winkler et al.			
	11.	05/02/95	5,412,087	McGall et al.			
	12.	6/13/95	5,424,186	Fodor et al.			
	13.	09/19/95	5,451,683	Barrett et al.			
	14.	01/16/96	5,484,904	Nilsen et al.			
	15.	01/30/96	5,487,973	Nilsen et al.			
	16.	04/23/96	5,510,270	Fodor et al.			
	17.	06/18/96	5,527,681	Holmes			
	18.	08/13/96	5,545,531	Rava et al.			
	19.	08/20/96	5,547,839	Dower et al.			
	20.	09/03/96	5,552,280	Urdea et al.			
	21.	10/01/96	5,561,043	Cantor et al.			
	22.	11/05/96	5,571,639	Hubbell et al.			
	23.	11/05/96	5,571,670	Urdea			
	24.	11/26/96	5,578,832	Trulson et al.			
	25.	12/03/96	5,580,731	Chang et al.			
	26.	01/07/97	5,591,584	Chang et al.			
	27.	01/14/97	5,594,117	Urdea et al.			
	28.	01/24/97	5,594,118	Urdea et al.			

EXAMINER:

Houm K. Chakrabarti

DATE CONSIDERED:

1/7/04

EXAMINER: Initial if citation considered, whether or not the citation conforms with MPEP 609. Draw a line through the citation if not in conformance and not considered. Include a copy of this form with next communication to applicant.

PTO/SB/08 (2-92)

Sheet 2 of 14

m PTO-1449

INFORMATION DISCLOSURE CITATION
IN AN APPLICATION

(Use several sheets if necessary)

Docket Number

Application Number

Applicant

Martin J. GOLDBERG et al.

Filing Date

Group Art Unit

U.S. PATENT DOCUMENTS

Examiner Initials	Ref. No.	Date	Document No.	Name	Class	Subclass	Filing Date If Appropriate
Ac	29.	01/28/97	5,597,909	Urdea et al.			
	30.	02/04/97	5,599,695	Pease et al.			
	31.	03/25/97	5,614,362	Urdea			
	32.	04/29/97	5,624,711	Sundberg et al.			
	33.	04/29/97	5,624,802	Urdea et al.			
	34.	05/13/97	5,629,153	Urdea			
	35.	05/20/97	5,631,734	Stern et al.			
	36.	08/12/97	5,656,731	Urdea			
	37.	10/14/97	5,677,195	Winkler et al.			
	38.	12/30/97	5,702,893	Urdea et al.			
	39.	01/20/98	5,710,000	Sapolsky et al.			
	40.	01/20/98	5,710,264	Urdea et al.			
	41.	04/07/98	5,736,316	Irvine et al.			
	42.	04/28/98	5,744,305	Fodor et al.			

FOREIGN PATENT DOCUMENTS

Examiner Initials	Ref. No.	Date	Document No.	Country	Class	Subclass	Translation YES NO
	43.	05/05/89	WO 89/03891	PCT			
	44.	02/20/94	WO 92/02526	PCT			
	45.	06/25/92	WO 92/10092	PCT			
	46.	05/27/93	WO 93/09668	PCT			
	47.	03/20/97	WO 97/10365	PCT			
	48.	08/14/97	WO 97/29212	PCT			
	49.	11/13/97	WO 97/42211	PCT			
	50.	11/13/97	WO 97/42213	PCT			
✓	51.	11/13/97	WO 97/42218	PCT			
AC	52.	12/11/97	WO 97/46703	PCT			

EXAMINER:

Atomi K. Chakrabarti

DATE CONSIDERED:

1/22/04

EXAMINER: Initial if citation considered, whether or not the citation conforms with MPEP 609. Draw a line through the citation if not in conformance and not considered. Include a copy of this form with next communication to applicant.

PTO/SB/08 (2-92)
Sheet 3 of 4

Form PTO-1449

INFORMATION DISCLOSURE CITATION
IN AN APPLICATION

(Use several sheets if necessary)

Docket Number:

Application Number

Applicant

Martin J. GOLDBERG et al.

Filing Date

Group Art Unit

OTHER DOCUMENTS

(including author, title, date, pertinent pages, etc.)

Examiner Initials	Ref. No.	Title
Ac	53.	Bayer and Wilchek. "Labeling and detection of proteins and glycoproteins." <u>Nonradioactive Labeling and Detection of Biomolecules</u> . Kessler, C., Ed. New York: Springer-Verlag, 1992. pp. 91-100.
	54.	Cardullo. "Nonradioactive fluorescence energy transfer." <u>Nonradioactive Labeling and Detection of Biomolecules</u> . Kessler, C., Ed. New York: Springer-Verlag, 1992. pp. 414-423.
	55.	Chee. (25 October 1996). "Accessing genetic information with high-density DNA arrays," <i>Science</i> . 274:610-614.
	56.	Cimino et al. (1985). "Psoralens as photoactive probes of nucleic acid structure and function: Organic chemistry, photochemistry, and biochemistry," <i>Ann Rev. Biochem.</i> 54:1151-1193.
	57.	Howard, G. "Labeling proteins with fluorochromes." <u>Methods in Nonradioactive Detection</u> . Howard, G., Ed. Norwalk, CT: Appleton and Lange, 1993. pp. 39-68.
	58.	Kessler, C. "Overview of nonradioactive labeling systems." <u>Nonradioactive Labeling and Detection of Biomolecules</u> . Kessler, C., Ed. New York: Springer-Verlag, 1992. pp. 27-34.
	59.	Levenson et al. (1990). "Biotinylated psoralen derivative for labeling nucleic acid hybridization probes," <i>Methods Enzymol.</i> 184:577-583.
	60.	<u>Methods in Nonradioactive Detection</u> . Howard, G. Ed. Norwalk, CT: Appleton and Lange, 1993. pp. 11-27.
	61.	<u>Methods in Nonradioactive Detection</u> . Howard, G. Ed. Norwalk, CT: Appleton and Lange, 1993. pp. 137-150.
	62.	<u>Nonradioactive Labeling and Detection Systems</u> . Kessler, C., Ed. New York: Springer-Verlag, 1992. 70-99.
✓	63.	de Saizieu et al. (January 1998). "Bacterial transcript imaging by hybridization of total RNA to oligonucleotide arrays," <i>Nat. Biotechnol.</i> 16(1):45-48.
Ac	64.	Van de Plas. "Colloidal gold as a marker in molecular biology: The use of ultra-small gold particles." <u>Nonradioactive Labeling and Detection of Biomolecules</u> . Kessler, C., Ed. New York: Springer-Verlag, 1992. pp. 116-126.

EXAMINER:

Arum K. Chakrabarti

DATE CONSIDERED:

1/7/04

EXAMINER: Initial if citation considered, whether or not the citation conforms with MPEP 609. Draw a line through the citation if not in conformance and not considered. Include a copy of this form with next communication to applicant.

FORM PTO-1449 (modified)
To: U.S. Department of Commerce
(PW FORM PAT-1449)
Patent and Trademark Office

Atty.
Dkt. No.

Inv.

Client Ref.

0266874

3088.2

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

Applicant: GOLDBERG et al.

Continuation of Appin. No.: 09/276,774

Filing Date: March 25, 1999

Date: February 6, 2001

Page 4 of 4

Examiner:

Group Art Unit:

U.S. PATENT DOCUMENTS

Examiner's Initials*	Document Number	Date MM/YYYY	Name (Family Name of First Inventor)	Class	Sub Class	Filing Date (if appropriate)
AC	AR 5,635,352	06/1997	Urdea et al.			
	BR 5,804,384	09/1998	Muller et al.			
	CR 5,512,438	04/1996	Stone			
	DR 5,175,270	12/1992	Nilsen et al.			
	ER					
	FR					
	GR					
	HR					

FOREIGN PATENT DOCUMENTS

FOREIGN PATENT DOCUMENTS						English Abstract		Translation Ready Available		
		Document Number	Date MM/YYYY	Country	Inventor Name		Enclosed	No	Enclose	No
		IR 0 154 884 A2	09/1985	Europe						
		JR WO 90/04786	05/1990	WIPO						
		KR WO 93/24658	12/1993	WIPO						
		LR WO 95/20320	08/1995	WIPO						
		MR WO 98/04745	02/1998	WIPO						
		NR WO 98/18488	05/1998	WIPO						
		OR								
		PR								
		QR								
		RR								

OTHER (Including in this order Author, Title, Periodical Name, Date, Pertinent Pages, etc.)

SR	Kerstens, H. et al., "A Novel in Situ Hybridation Signal Amplification Method Based on the Deposition of Biotinylated Tyramine," J. Histochemistry and Cytochemistry (1995) 43(4):347-352
TR	European Search Report 99250336.7 dated February 3, 2000
UR	
VR	
WR	
XR	
YR	
ZR	
AAR	

Examiner

Arum K. Chakrabarti

Date Considered:

1/7/04

*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.